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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,882	10/18/2001	Charles Gordon Hooks	AUS920010745US1	7337
45371	7590	05/05/2005	EXAMINER	
IBM CORPORATION (RUS) C/O SIEGESMUND & ASSOCIATES 4627 NORTH CENTRAL EXPRESSWAY, SUITE 2000 DALLAS, TX 75206			SHAH, SANJIV	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,882

Applicant(s)

HOOKS, CHARLES GORDON

Examiner

Sanjiv D. Shah

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/18/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's election with traverse of claims 1-17 in the reply filed on 1/10/2005 is acknowledged. The traversal is on the ground(s) that examiner improperly classified case in class 715 whereas applicant believes that the application should have been classified in class 707. Examiner disagrees. The invention is comparing two files (documents). It falls under document processing class 715. Therefore the invention is classified properly

Applicant argues that process of comparing new string and old string is common to each invention. This is not found persuasive because inventions I and II are restricted as process and apparatus as clearly recited in the restriction requirement. Applicant argues about the functionality but fails to traverse the specifics of the restriction.

Inventions II and III are restricted as combination subcombination. Applicant argues that "claim 25 recites a first computer, having first storage medium and a second computer with second storage medium. The files are located in second storage medium and comparison and compression programs are located in first storage". Applicant argues that it is not clear how this arrangement achieves separate utility. Examiner disagrees. Applicant unsuccessfully argues based on claim 25 but restriction is between Group II and III. Combination-Subcombination as well as separate utility is properly applied to the restriction. Applicant have failed to present argument based on comparison of two groups. Examiner have properly indicated that search required for Group II and Group III is not required for Group I. Therefore restriction is proper.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Claims 18-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/10/2005.
3. Claims 1-17 are pending.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Analysis: As per claims 1-17, the claimed invention is in technological art. The claimed invention is a method of comparing plurality of sources from a new file and old file comprising creating compressed string. The claimed invention is a series of steps performed. However, the claimed invention is not limited to practical application and therefore is considered an abstract idea without limitation to practical application. Specifically, claimed steps can be performed on paper. It is recommended to include a limitation of "computer implemented method" to overcome this rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 8-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sliger et al. (Patent # 6,494,974).

Regarding claim 1, Sliger et al. teaches the claimed invention of comparing plurality of sources from a new file and old file comprising creating compressed string as shown in fig 7 and col. Col. 3, lines 7-10, wherein new and old files are compared to create compressed string.

Regarding claim 8, Sliger et al teaches the claimed invention of determining whether selected line from old file is identical to line from new file. Specifically Sliger teaches comparing old file with new file as shown in fig 7. It is inherent that a determination is made if the line in old file is identical to new file.

Regarding claims 9 –17, Sliger teaches the claimed invention of loading the line form the old file, determining the length, Comparing with new file and determining the match is described in col. 1, lines38-67. comparing is shown in fig 7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sliger et al. (Patent # 6,494,974).

Regarding claim 2, Sliger et al. teaches the claimed invention as described above with respect to paragraph 6. Sliger et al does not specifically teach removing all blank spaces except codes within quotation marks. However Sliger et al. teaches a normalization process, that is essentially removing any differences that would be created as a result of modifications as described in col. 9, lines 19-35. Obviously, normalization removes blank spaces. Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate Normalization process to remove blank spaces because it provides faster compression by reducing processing time.

9. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sliger et al. (Patent # 6,494,974) in view of Cheng et al. (Patent # 5,608,396).

Regarding claims 3, 4, 5, 6, Sliger fails to teach a step of placing all characters in a word consisting of four bytes of storage cell. However Cheng et al. does. Specifically, Cheng et al. teaches storing characters in a word as shown in fig 8B. Bucket size consist of various bytes including 4 byte word as claimed. A pointer associated with word is described in col. 5, lines 27-40. Inserting a control codes in to the compression

string is described in the abstract, lines 17-24. Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate compressing into 4 byte word as taught by Cheng in the method of Sliger because it provides efficient compression.

Regarding claim 7, Cheng fails to teach pointers as a link array. However pointers are addresses and so are links. Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to replace pointers with link arrays because it aids determining starting and ending point of matching stream.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2176

S. Shah
May 02, 2005